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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,992	02/25/2004	Jiacheng Zhou	DM-6964C (BMS-2595)	6780

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EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,992

Applicant(s)

ZHOU ET AL.

Examiner

EBENEZER SACKEY

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Status of Claims**

Claims 10 and 11 and new claim 12 are pending.

This is in response to the amendment filed 10/22/04.

### **Claim Rejections - 35 U.S.C. § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over John Sheehan (U.S. Patent number 3,558,318).

While species of Sheehan and D'Silva no longer anticipate claims 11 or 12, newly added, they are obvious variants for the following reasons.

Compounds embraced herein are generically taught by Sheehan, as they are higher homologs of the species previously pointed out in 102 rejection. Note that substituent R in Sheehan can be lower alkyl of 1-6 carbons.

Claim 12, which requires at least disubstitution on the phenyl ring, is also rejected since closest instant compounds to  $\alpha$ -phenyl species in Sheehan differ only in having 2 methyl groups. Note that hydrogen vs. 1 or 2 methyl groups in otherwise old compounds is not considered patentable absent evidence of superior, unexpected results. Note *In re Wood*, 199 USPQ 137; *In re Lohr*, 137 USPQ 548; *In re Fauque*, 121 USPQ 425. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to expect compounds claimed herein that are methylated on a carbon chain to possess the uses taught by the art (useful as dyes) in view of the equivalency teaching and close structural similarity outlined above. The instantly claimed compounds would therefore have been suggested to one of ordinary skill in the art.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Silva (U.S. Patent number 4,469,688).

Compounds embraced herein are generically taught by D'Silva, as they are lower homologs of the species previously anticipated. Note that variable R<sub>1</sub> in D'Silva can be

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alkyl of 1-10 carbons. Note preferred embodiments corresponding to final product include  $R_1$  as lower alkyl.

Claim 12, which requires at least a disubstitution on the phenyl ring is also rejected since closest instant compound in D'Silva namely example 1 differs in having 1 hydrogen vs. instant disubstitution groups. Note that D'Silva teach substituents instantly embraced can be present one or more times on phenyl ring. See definition of  $R_n$  in column 1.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to expect compounds claimed herein to also be useful as precursors to cyano enol phosphate final products in view of the equivalency teaching and close structural similarities outlined above. It is noted that instant compounds are also taught as precursors to compounds having corticotropin releasing factor (CRF) receptor antagonist activity.

Compare *In re Lalo*, 223 USPQ 1257 (1984) with *In re Magerlein*, 202 USPQ 473 (1979).

Claim 10 is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-1600.

EOS

January 4, 2005

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*E Bernhardt*  
EMILY BERNHARDT  
PRIMARY EXAMINER  
GROUP 120